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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/896,838

06/29/2001

Dwight Marcus

NPOWR-3-US

5872

45722

7590

05/30/2008

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EXAMINER

BEKERMANN, MICHAEL

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

05/30/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/896,838	<b>Applicant(s)</b> MARCUS, DWIGHT	
	<b>Examiner</b> MICHAEL BEKERMAN	<b>Art Unit</b> 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 148-163 is/are pending in the application.
- 4a) Of the above claim(s) 158-162 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 148-157 and 163 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

This action is responsive to papers filed on 2/20/2008.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **Claims 148 and 151 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

**Regarding claim 148**, this claim recites the limitation “at least one of said plurality of signifiers does not have significance in connection with a meaning of said provided information”. This limitation is not recited in the specification and is considered to be new matter.

**Regarding claim 151**, this claim recites the limitation “said text form signifiers not pertaining to information on the topic”. This limitation is not recited in the specification and is considered to be new matter.

2. **Claim 153 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

**Regarding claim 153**, this claim recites the limitations “the text form information comprises instructional material relating to a product or service” and “after said step of verification...making available to the information customer support associated with the product or service in a first manner...” The claim appears to comprise the steps of providing, verifying, and then after the verification, making product support available to the customer. This process is not recited in the specification. According to the specification, the consumer may read a product manual to obtain a toll-free customer service number (Page 26). There appears to be no step of verification in this embodiment. If the consumer finds the toll-free number, then the product support is made available by calling the number without any verification required. To further explain, this claim requires the step of verification (calling the number). Then, if sufficient knowledge is demonstrated (the number was called), product support is provided in one fashion. If sufficient knowledge is not displayed, product support is provided in a second fashion. This is unclear, because the specification does not disclose a second product support feature should the customer not dial the toll free number.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**3. Claims 148, 151, and 152 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Regarding claim 148**, this claim recites the limitation “at least one of said plurality of signifiers does not have significance in connection with a meaning of said provided information”. However, claim 1 (from which this claim depends) recites “providing said provided information having a plurality of signifiers inserted therein”. If signifiers are inserted in the provided information, this association appears to be rather significant. Examiner is unclear as to how a signifier could have no significance to provided information when the signifier is significantly inserted into the provided information. Further, it is unclear what the “meaning” of a provided information is supposed to be. There are courses taught at universities across the US in which books are analyzed to attempt to discover an author’s “meaning”, and every student typically comes away with a different meaning. Which meaning is supposed to have no significance to the signifiers?

**Regarding claim 151**, this claim recites the limitation “said text form signifiers not pertaining to information on the topic”. However, this claim also recites “text form information having a plurality of text form signifiers inserted therein”. If text form signifiers are inserted in the text form information, this association would appear to pertain to the topic of the text form information. Examiner is unclear as to how a text

form signifier could not pertain to a topic of text form information when the signifier is significantly inserted into the text form information.

**Regarding claim 152**, this claim recites the limitation “the text form information has instructions for indicating knowledge of the signifier”. This appears to be a topic of the text form information. However, claim 151 from which this claim depends recites the limitation “said text form signifiers not pertaining to information on the topic”. It is unclear how text form information may contain instructions for indicating knowledge of signifiers that are supposed to have nothing to do with the text form information in the first place.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1 and 148-150 are rejected under 35 U.S.C. 102(b) as being anticipated by McGregor (U.S. Patent No. 5,236,200).** McGregor teaches a method of providing an incentive that includes all of the limitations recited in the above claims.

**Regarding claim 1**, McGregor teaches providing information to an information consumer (treasure hunt game card) (Figure 1) with a plurality of signifiers enclosed therein (clues) (Column 1, Lines 59-63). A signifier use instruction is inherent when the

treasure hunt game is provided (follow the clues to get to the treasure). Should the information consumer display sufficient knowledge of the clues, they will receive an incentive (the treasure/gift) (Column 1, Lines 59-63). The claim language is very broad and does not specify who performs the steps of the method. Therefore, the step of receiving could be performed by an onlooker or the consumer himself (both of which would be inherent). A step of determining could also be done by an onlooker or the consumer himself (if the consumer finds the prize, this proves to the consumer or an onlooker that the consumer knows how to read the clues).

**Regarding claim 148**, the picture on the front of the treasure hunt card (Figure 1) does not appear to have any notable significance to the clues on the card and vice versa.

**Regarding claims 149 and 150**, McGregor teaches anagrams and puzzles as clues (Column 3, Lines 14-22). This represents a conversion code for conversion of the clue to another type of information that may be used to locate and claim the incentive (contact information).

5. **Claims 151-155 and 163 are rejected under 35 U.S.C. 102(a) as being anticipated by Sony (Owner's Manual, Sony Video Cassette Recorder Model SLV-662HF, 1999).** Sony teaches providing access to a toll-free phone number that includes all of the limitations recited in the above claims.

**Regarding claims 151, 153-155, and 163**, Sony teaches providing text form information (the manual itself) having text form signifiers enclosed within (the toll-free

phone number at the bottom of the last page). If the consumer reviews the Sony manual and finds the phone number, then the customer is rewarded with toll-free customer service. However, if the customer does not sufficiently review the manual to find the toll-free phone number, they will inherently need to seek other options for customer service, such as driving to a retail establishment (which would inherently cost more than a toll-free number would). The numbers in the phone number are each in a different location than the other numbers (in 80, the 8 is beside the 0, and this reads on plural locations and being located “throughout” the manual).

**Regarding claim 152**, Sony recites “If you have any questions about this product, you may call” (bottom of the last page). This reads on “instructions for indicating knowledge of the signifier”.

6. **Claims 151, 156, and 157 are rejected under 35 U.S.C. 102(b) as being anticipated by Benson (U.S. Patent No. 3,926,325).** Benson teaches a method of providing access to medication that includes all of the limitations recited in the above claims.

**Regarding claims 151, 156, and 157**, Benson teaches providing information on the side of bottles (provided text form information) including instructions about how to open the child-proof cap (text form signifiers) (Figure 3, Column 1, Lines 26-37). The bottle of Benson is meant for medicine (Column 2, Lines 39-41), and thus the text form provided information are medical instructions. Should the consumer display sufficient knowledge of the signifiers, they may use the signifiers (instructions) to gain access to

the medication within the bottle. The claim language is very broad and does not specify who performs the steps of the method. Therefore, the step of receiving could be performed by an onlooker or the consumer himself (both of which would be inherent). A step of verifying could also be done by an onlooker or the consumer himself (if the consumer is taking the medicine, this proves to the consumer or an onlooker that the consumer knows how to open the bottle). Each letter of the directions on the bottle of Benson are in a different location than the other letters (in "discard", the "d" is beside the "i", and this reads on plural locations).

### ***Response to Arguments***

7. Applicant argues "Claim 148 is a generic claim reciting that at least one of the plurality of signifiers does not have significance in connection with the provided information. It is well established that the written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species". While this is true, Applicant has shown no sufficient description from the specification that teaches claim 148. Applicant provides an example from Page 24, lines 5-6 and claims "the colors do not have significance in connection with the information provided in the video program". However, Examiner would like to point out that there are television shows in which colors matter such as "Get Color!" on HGTV, in which the host repaints colorless rooms in new innovative ways. In this situation, the colors, or a sequence of colors, are very important to the program content. Applicant's example from the specification fails to point out what the provided content is, and

therefore it is impossible to say whether there is significance or not. Further, Examiner would like to remind Applicant that if the colors are included in the program, those colors are significant.

Applicant gives another example from Page 22, lines 4-5, and claims “the signifiers do not have significance in connection with the information provided in the sentence”. The portion of the specification cited by the Applicant merely points out that the signifiers are in a normally typeset sentence. Applicant’s example from the specification fails to point out what the provided content is, and therefore it is impossible to say whether there is significance or not. Further, Examiner would like to remind Applicant that if the signifiers are included in the sentence, those signifiers are significant. This rationale goes for claim 151 as well.

8. With reference to claim 153, Applicant argues that “in the specification at page 26, lines 19-20, calling the toll-free number constitutes a step of verification”. Examiner has added additional explanation to the rejection above in order to better clarify the issue at hand. Essentially, there is an “if/else” statement in the claim that is not supported by the specification.

9. Applicant amended claim 148 with the language “a meaning of” and states “specification support is found, for example, at page 7, lines 12-19, which discusses signifiers that may be colors of particular shapes”. As stated above, the section cited by Applicant does not mention anything about the content or meaning of the information. The colors of the shapes may be important to the meaning of the information, but the specification is silent with respect to this.

10. Applicant argues "the fact that a signifier is inserted in text form information does not imply that the signifier pertains to information on the topic of the text form information. An example of such text form signifier is given in the specification, at page 22, lines 9-14 as "This sentence contains the signifier word "angry", please copy down the letter at the end of this word." This signifier does not provide information on the topic of the text form information, and indeed can be inserted in text form information on any topic". The "topic" of the sentence from the specification cited by Applicant appears to be "reading comprehension", in which the "y" would indeed pertain to information on the topic. As a broader interpretation, the "topic" of the sentence could be "random letters thrown together to possibly form a sentence". In this case, the "y" would once again pertain to information on the topic. As explained above, , the section cited by Applicant does not mention anything about the content or meaning of the information.
11. Applicant states "The step of receiving is at least inherent in the disclosure". Likewise, and as explained above, a step of receiving would be inherent in the previously cited prior art from the last Office Action.
12. All other arguments that have not been addressed here are believed to be addressed by the amended claim language above.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL BEKERMAN whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MB

/Eric W. Stamber/  
Supervisory Patent Examiner, Art Unit 3622